

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of	)	<b>MAIL STOP AF</b>
Franz-Josef Koerber	)	Group Art Unit: 2837
Application No.: 10/568,751	)	Examiner: David S. Luo
Filed: February 21, 2006	)	Confirmation No.: 6674
For: APPARATUS FOR ACTUATING AN	)	
ELECTRICAL SWITCHING DEVICE	)	

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. This request is void of amendments and is filed concurrently with a Notice of Appeal.

In numbered paragraph 2 on page 2 of the Office Action, claims 1-22 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Marin-Pache* (U.S. Patent No. 6,506,990), and further in view of *Byers* (U.S. Patent No. 6,693,247). Applicant respectfully traverses this rejection.

In the previous response, Applicant argued that the combination of *Marin-Pache* and *Byers* fails to disclose or suggest at least that the first axis of the drive shaft runs parallel to the second axis of the rotating shaft in a common horizontal plane, as recited in independent claim 1.

The Examiner concedes that neither *Marin-Pache* nor *Byers* discloses or suggests this feature and relies on the teachings of *Weston* as evidence of the knowledge in the art and in an effort to remedy this deficiency.

*Weston* discloses a circuit breaker mechanism having an inner shaft 42a and an outer shaft 22a. An auxiliary shaft, which is 92 used in the process of closing main and vacuum contacts, is spaced from the shaft 22a and mounted for rotation in a housing 88. See Weston, col. 5, line 5 thru col. 6, line 8; Figs. 9, 10, 11. The Examiner alleges that the relationship among the shafts 92 and 42a is analogous to the relationship between the first axis of the drive shaft and second axis of the rotating shaft as recited in claim 1. *Weston*, however, does not provide any evidence in the disclosure to support the Examiner's position. There is no discussion regarding the relationship of any of the shafts in *Weston* that would lead one of skill in the art to conclude that the claimed feature is disclosed therein as alleged.

Even assuming *arguendo* that *Weston* can be reasonably considered to support the Examiner's interpretation, there is still no apparent nexus between *Weston* and the combination of *Marin-Pache* and *Byers* to render the claims obvious. Namely, the alleged feature of *Weston* does not present a mere substitution of parts, but rather a modification of the structural components in the *Marin-Pache/Byers* combination and particularly in the structure of *Marin-Pache*. To realize in *Marin-Pache* a feature in which the first axis of the drive shaft runs parallel to the second axis of the rotating shaft in a common horizontal plane, would require a modification to *Marin-Pache* that would render the device either incapable of operation or incapable of achieving the stated objective. In other words, while the alleged relationship between shafts 92 and 42 is applicable for the functional design in *Weston*, there is no dispositive or suggestive evidence that supports the applicability of this same relationship in *Marin-Pache*. The mere knowledge of such a

relationship as disclosed in *Weston* is insufficient to establish obviousness if the modification would destroy the principal operation of *Marin-Pache*.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

*Marin-Pache* discloses a kinematic system defines five geometric axes of parallel rotation. The shafts 140 and 142 are both fixed with respect to the support 83, and the other three shafts (144, 146, 148) are mobile. See *Marin-Pache*, col. 5, lines 45-47. However, based upon a reasonable and prudent reading of the reference, one of skill in the art would understand that no two of the five geometric axes together establish a structure such as Applicant's claimed first axis of the drive shaft and second axis of the rotating shaft, wherein the first axis of the drive shaft runs parallel to the second axis of the rotating shaft in a common horizontal plane.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). In this instance, other than stating that Applicant's claimed structure

is known, the Examiner has not provided any reasons why an artisan would modify *Marin-Pache* with the teachings of *Weston* to achieve Applicant's claimed embodiment.

In summary, the *Marin-Pache* and *Byers* patents when applied alone or in combination as alleged by the Examiner fail to disclose or suggest at least all of the features and/or the combination of features recited in Applicant's claims. For at least this reason, a *prima facie* case of obviousness has not been established and withdrawal of this rejection is deemed appropriate.

### Conclusion

Based on at least the foregoing amendments and remarks, Applicant submits that claims 1-11 and 13-22 are allowable, and this application is in condition for allowance. Applicant requests favorable examination and consideration of the instant application. In the event the instant application can be placed in even better form, Applicant requests that the undersigned attorney be contacted at the number listed below.

Respectfully submitted,

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